

Application No. 10/626,263

Docket No.: 30565/38931

**REMARKS**

Claims 1-33 were examined in the most recent Office Action, dated September 13, 2005. By way of the Office Action, all claims stand rejected as either anticipated by or obvious over Yates, U.S. Patent No. 2,283,026; Nelson, U.S. Patent No. 6,139,210; Rappaport, U.S. Patent Application No. 2002/0116854; Platt, U.S. Patent No. 3,279,311; and/or Holcomb, U.S. Patent No. 4,838,708. Applicant traverses the rejection for the reasons outlined herein.

**Applicant's Interview Summary**

Applicant appreciates the Examiner taking the time to conduct a telephonic interview on October 17, 2005. The Examiner, Bryon Gehman, and applicant's representatives, Roger Heppermann and Russell Petersen attended.

During the interview, the Examiner agreed that none of the cited references discloses a liquid tight pocket in a document storage apparatus. The participants discussed the disclosures of the references cited in the most recent office action, Yates and Nelson. The participants agreed that while Yates and Nelson each disclose a photo sheet with an adhesive, neither discloses, either expressly or inherently, that the photo sheet forms a water tight pocket. The Examiner requested that Applicant respond to the office action in writing. Further, the Examiner requested minor amendments of clarification to the claims to describe the pocket being watertight and to eliminate the phraseology "watertight fashion". These amendments are not substantively related to the patentability of the claims.

Application No. 10/626,263

Docket No.: 30565/38931

Claim 1 is Allowable.

Applicants traverse the rejection to claim 1 as anticipated by Yates and as separately anticipated by Nelson. Claim 1 now recites, in part, an adherent adapted to selectively adhere the first transparent sheet to the second sheet to close the pocket, so that the pocket is liquid tight. Neither Yates nor Nelson expressly or inherently discloses or suggests a pocket that is liquid tight.

While Yates discloses a backing sheet 63, a film-like base sheet 58, and an adhesive coating 61 disposed on one face of the base sheet 58, Yates fails to teach that the adhesive coating 61 adheres to the backing sheet 63 to form a liquid tight pocket between the backing sheet 63 and the base sheet 58. While a photo can be placed between the base sheet 58 and the backing sheet 63, and the two sheets 58, 63 can be pressed together to store the photo therebetween, Yates discloses that the adhesion between the coating 61 and the backing sheet 63 is easily releasable. For example, Yates teaches that the surface of the backing sheet 63 "has been treated with an oil which is incompatible with the adhesive coating [61] to reduce adhesion thereto, and promoting ready separation of the backing sheet [63] therefrom." Page, 1, col. 1, line 58 - col. 2, line 2. Yates fail to disclose that this bond forms a liquid tight pocket.

While Yates discloses an integral bond between the base sheet 58 and the adhesive coating 61 (see page 1, col. 2, lines 3-18) so that the adhesive 61 will not color or dry out through absorption of moisture, Yates fails to disclose that the bond between the adhesive 61 and the backing sheet 63 creates a liquid tight pocket. Accordingly, there is no express disclosure in Yates of a liquid tight pocket formed between the base sheet 58 and the backing sheet 63.

Application No. 10/626,263

Docket No.: 30565/38931

Furthermore, Yates does not inherently disclose a liquid tight pocket. "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." MPEP § 2112 (IV) (emphasis in original). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Id.* (emphasis in original). While an easily releasable bond might create a liquid tight pocket, it is not necessarily the case that the adhesive 61 of Yates creates a liquid tight pocket. The Office Action provides no basis in fact and/or technical reasoning to support a determination that the adhesive in Yates is necessarily liquid tight. Because Yates does not necessarily describe a liquid tight pocket, claim 1 is novel over Yates.

Nelson also fails to disclose a liquid tight pocket. While Figure 5 of Nelson discloses a photo sheet 14 with a transparent wall 19 and a flexible or rigid backing 34 that are connected by a layer of adhesive 32 to form a pocket 16, Nelson completely fails to disclose that the adhesive creates a liquid tight pocket. Again, Nelson fails to inherently disclose the aspects of claim 1, because it is not necessarily the case that the adhesive 34 in Nelson creates a liquid tight pocket. The Office Action provides no basis in fact and/or technical reasoning to support a determination that the adhesive in Nelson is necessarily liquid tight. Because Nelson does not necessarily describe a liquid tight pocket, claim 1 is novel over Nelson.

Further, claim 1 is not suggested by the cited references, either alone or in combination. Because Yates and Nelson fail to disclose a liquid tight pocket, there is simply no suggestion within either Yates or Nelson to make the pocket liquid tight. Further, none of the secondary references, Rappaport, Holcombe, or Platte, suggests combining their features

Application No. 10/626,263

Docket No.: 30565/38931

with either Yates or Nelson to form the recited document storage apparatus with a liquid tight pocket.

Rappaport discloses a pocket that is not liquid tight. First, Rappaport discloses a series of perforations 28 that extend along the edge of the postcard holder 8. Further, Rappaport discloses a gap devoid of adhesive between the adhesive strip 24 and the line of perforations 28. The perforations and gap destroy the liquid tight integrity of the pocket. Accordingly, Rappaport fails to disclose or suggest a liquid tight pocket.

Holcombe and Platte disclose plastic bags and were simply cited to show that certain adhesives are known to adhere to plastic. Holcombe and Platte fail to suggest combining the structure of the plastic bags with the photo sheet of either Yates or Nelson.

For at least these reasons, claim 1 is allowable over the art of record. Additionally, dependent claims 2-20, which depend from claim 1, are allowable for least these reasons.

Claims 21-30 are Allowable.

Independent claims 21 and 24 stand rejected as anticipated by both of Yates and Nelson. Independent claim 30 stands rejected as obvious over both Yates in view of Rappaport and Nelson in view of Rappaport. Claim 21 recites, in part, closing the open end of the pocket such that the pocket is liquid tight. Claim 24 recites, in part, that the adherent is selectively applicable to close the pocket, such that the pocket is liquid tight. Claim 30 recites, in part, that the adhesive is adapted to selectively adhere the first sheet to the second sheet across the open end to close the pocket, such that the pocket is liquid tight.

As has been outlined earlier, none of Yates, Nelson, and Rappaport discloses or suggests a liquid tight pocket. Holcombe and Platte fail for the same reasons as outlined earlier. Accordingly, independent claims 21, 24, and 30 are allowable over the cited

Page 12 of 13

Application No. 10/626,263

Docket No.: 30565/38931

references for at least these reasons. Dependent claims 22, 23, 25-29, and 31-33 are allowable for at least these reasons as well.

**CONCLUSION**

In view of the foregoing remarks, it is submitted that the claims as now appearing in this application are in form for allowance. A favorable action on the part of the Examiner is respectfully solicited. If, in the opinion of the Examiner, a telephone conference would expedite prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

No fee is believed due with this response. However, the Commissioner is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 13-2855, under Order No. 30565/38931/US.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP  
6300 Sears Tower  
233 South Wacker Drive  
Chicago, Illinois 60606  
312-474-6300

By: 

Russell C. Petersen  
Registration No. 53,457  
Attorney for Applicant

December 13, 2005